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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

16

DATE MAILED: 02/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,898

Applicant(s)

KOLATA ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 37 is/are rejected.
- 7) ☒ Claim(s) 7-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 3732

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-4, 6 and 37 are rejected under 35 U.S.C. 102(b) as being unpatentable over Blake (US 5,944,729).

Regarding claims 1, 3-4, 6 and 37, Blake discloses a medical instrument 10 which can be used as a gripping instrument having: a body 34 with tissue grasping claws (26, 26) selectively movable between an open position and a closed position with the tissue grasping claws biased to a closed position; an actuating member with opposed members (22, 22) mated to the body and effective to move the claws between open and closed positions and a flexible member or string 48 for placement, withdrawal or maneuvering of instrument 10 that is selectively fastenable to a support (Figures 1-3, col. 2, lines 30-67, col. 3, lines 1-45).

The method steps of claim 37 are performed during normal operation of the Blake medical instrument for the purpose of gripping tissue or an organ.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blake (US 5,944,729).

Regarding claim 5, although Blake does not disclose that tissue grasping elements (26,26) form a circular shape in the closed position, it would have been an obvious matter of design

Art Unit: 3732

choice to one skilled in the art at the time the invention was made to construct the tissue grasping elements with a circular shape, since Applicants have not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a tissue grasping element in the Blake instrument. *In re Dailey and Eilers*, 149 USPQ 47 (1966).

Response to Arguments

Applicants' arguments under "REMARKS," in Paper No. 15, filed on February 02, 2004, have been considered but are not persuasive.

Regarding Applicants' arguments with respect to claims 1, 3-6 and 37 that Blake does not disclose "tissue penetrating claws," it is the Examiner's position that how a structure is used ("tissue grasping" vs. "tissue penetrating" in the instant application) is irrelevant because the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Marsham*, 2 USPQ2d 1647 (1987). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983).

Applicant's arguments with regard to claim 5 do not overcome the rejections applied thereto, since Applicants' have not provided any convincing showing that circular-shaped jaws are nothing more than matter of design choice as asserted by the examiner. Applicants' have not provided any showing that the circular shape is "critical". Applicants' attention is directed to Page 8, lines 19-22 of the Specification of the instant application wherein Applicants' state that the tissue penetrating claws can have any shape. *In re Cole*, 140 USPQ 230 (CCPA 1964); *In re Kuhle*, 188 USPQ 7 (CCPA 1975); *In re Davies*, 177 USPQ 381 (CCPA 1973). **Mere arguments by counsel cannot take the place of evidence.** *In re Cole*, 236 F.2d 769, 773, 140 USPQ 230, 233 (CCPA 1964); *In re Walters*, 168 f.2d 79, 80, 77 USPQ 609, 610 (CCPA 1948); et al.

Art Unit: 3732

Allowable Subject Matter

Claims 7-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Anu Ramana

AR

2/18/04


EDUARDO C. ROBERT
PRIMARY EXAMINER